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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,928	08/22/2000	Guy Nathan	871-88	1262

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EXAMINER	
NALEVANKO, CHRISTOPHER R	
ART UNIT	PAPER NUMBER
2611	5

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/642,928	NATHAN ET AL.	
	Examiner	Art Unit	
	Christopher R Nalevanko	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 August 2000*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *7 and 8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *7 and 8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3,4*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claim 7 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,182,126. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 7 corresponds to Patent Claim 11 of U.S. Patent No. 6,182,126. Claim 7 is a broader recitation of Patent Claim 11 of U.S. Patent No. 6,182,126. It would have obvious to modify Patent Claim 11 so as not to include the three modes of operation so it alleviated selection of an operation mode by the user.

Allowance of Claim 7 would result in the unwarranted time-use extension of the monopoly granted for the invention as defined in Patent Claim 11.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 7 rejected under 35 U.S.C. 103(a) as being unpatentable over Banker et al in further view of Truckenmiller et al.

Regarding Claim 7, Banker shows a method of operating a home digital audiovisual information playback apparatus, the method comprising displaying menus with user-selectable system operation options, enabling a selection of desired audiovisual information for reproduction, effecting payment for the desired audiovisual information, inputting a user personal identification number, and receiving from a main server the desired audiovisual information only after payment has been effected and a valid personal identification number has been supplied (fig. 5a, 5b, 6a, 6b, col. 3 lines 35-38, col. 8 lines 25-45, col. 10 lines 1-67, col.. 11 lines 1-5). Banker fails to show that the system records the received media and that it is actually "downloaded." Truckenmiller shows a system that downloads audiovisual media from a head-end and can record the audiovisual data (col. 3 lines 25-35, col. 4 lines 40-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker with the recording capability of Truckenmiller so that the user would have access to the media at the his or her convenience.

Regarding Claim 8, Banker and Truckenmiller both fail to specifically state the ability to reproduce the data while it is being downloaded. Official Notice is given that it is well known and expected in the art to view data as it is downloaded. This is a common technique used in streaming data. Therefore it would have been obvious to one of

ordinary skill in the art at the time the invention was made to modify the system of Banker and Truckenmiller with the ability to view the data as it was being downloaded so that the customer did not have to wait to view the audiovisual data.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Russo U.S. Patent No. 6,025,868 discloses a stored program pay-per-play.

Dunn et al U.S. Patent No. 5,721,829 discloses a system for automatic pause/resume of content delivered on a channel in response to switching to and from that channel and resuming so that portion of the content is repeated.

Ullrich et al U.S. Patent No. 5,583,937 discloses a method for providing video programming nearly on demand.

Budow et al U.S. Patent No. 5,521,631 discloses an interactive digital video services system with store and forward capabilities.

Sartain et al U.S. Patent No. 5,914,712 discloses an interactive video system.

Nemirofsky et al U.S. Patent No. 5,880,769 discloses an interactive smart card system for integrating the provision of remote and local services.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R Nalevanko whose telephone number is 703-305-8093. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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PATENT EXAMINER